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| EXAMINER | |
| CHOI, PETER H | |
| ART UNIT | PAPER NUMBER |
| 3623 | |

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Please find below and/or attached an Office communication concerning this application or proceeding.

| | | |
|------------------------------|-------------------------------|-------------------------|
| Office Action Summary | Application No. | Applicant(s) |
| | 09/773,547 | LIU ET AL. <i>SL</i> |
| | Examiner Peter Choi | Art Unit 3623 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 02/02/01.

2a) This action is **FINAL**. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-32 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) Claim(s) _____ is/are allowed.
6) Claim(s) 1-32 is/are rejected.
7) Claim(s) _____ is/are objected to.
8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) Notice of References Cited (PTO-892)
2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 8/27/02.

4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
5) Notice of Informal Patent Application (PTO-152)
6) Other: ____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 12-16, 18, 21-22 and 30-31 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 12 recites the limitation "said payment gate server" in line 3. There is insufficient antecedent basis for this limitation in the claim. However, line 2 refers to a payment gateway server. For purposes of the following art rejection, the "said payment gate server" of claim 12 is being interpreted as being a reference to the payment gateway server mentioned in line 1.

Claim 18 recites the limitation "said survey processing server" in line 1. There is insufficient antecedent basis for this limitation in the claim. However, the system of claim 12 refers to a survey processing center. For purposes of the following art rejection, the "said survey processing server" of claim 18 is being interpreted as being a reference to the survey processing center mentioned in claim 12.

The term "a commodity providing concern" in claim 21 is a relative term that renders the claim indefinite. The term "concern" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. For the purposes of the following art rejection, the examiner has interpreted "concern" to be a business establishment or enterprise. Claim 21 has been interpreted to be the "system of claim 10, wherein said system is usable with a business establishment or enterprise providing products bought and sold in commerce".

Claim 30 recites the limitation "said card" in line 4. There is insufficient antecedent basis for this limitation in the claim. For purposes of the following art rejection, the "said card" of claim 30 is being interpreted as "a card".

Claim 30 recites the limitation "said transaction" in line 5. There is insufficient antecedent basis for this limitation in the claim. For purposes of the following art rejection, the "said transaction" of claim 30 is being interpreted as "a transaction".

Claim 30 recites the limitation "said customer" in line 7. There is insufficient antecedent basis for this limitation in the claim. For purposes of the following art rejection, the "said customer" of claim 30 is being interpreted as "a customer".

Claim 31 recites the limitation "said credit card" in lines 3 - 4. There is insufficient antecedent basis for this limitation in the claim. For purposes of the following art rejection, the "said card" of claim 30 is being interpreted as "a credit card".

Claim 31 recites the limitation "said transaction" in line 6. There is insufficient antecedent basis for this limitation in the claim. For purposes of the following art rejection, the "said transaction" of claim 31 is being interpreted as "a transaction".

Claim 31 recites the limitation "said customer" in line 8. There is insufficient antecedent basis for this limitation in the claim. For purposes of the following art rejection, the "said customer" of claim 31 is being interpreted as "a customer".

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-11, 17, 19-21, 23, and 27-32 are rejected under 35 U.S.C. 102(a) as being anticipated by Tedesco et al. (U.S Patent No. #6,161,059).

As per claim 1, Tedesco et al. teaches a system for conducting a survey, comprising:

a presentation unit (liquid crystal display unit or a light emitting diode display unit) for presenting a plurality of choices at a point-of-transaction terminal; [Column 5, lines 38-40]

an input unit (input device) for entering the preferred choices [Column 4, lines 44-47]; and

a recording unit (data storage device) for recording the entered choices. [Column 5, line 51 – Column 6, line 7]

As per claim 2, Tedesco et al. teaches the system of claim 1, further comprising:

a reward unit for rewarding a user (customer) making the choices (providing responses about their preferences or opinions in the form of a survey). [Column 3, lines 65-67]

As per claim 3, Tedesco et al. teaches the system of claim 2, wherein said reward includes at least one of a monetary reward, a discount (rebate) on a present purchase, a discount on a future (subsequent) purchase, and loyalty points for rewarding a frequent user. [Column 4, lines 17-20]

As per claims 4, 5 and 7, Tedesco et al. teaches a system for soliciting customer participation in a marketing promotion or survey. Customers are rewarded for providing

responses about their preferences or opinions in the form of a survey. [Column 3, lines 64-66] The survey asks questions regarding alternative products and locations to be served by the merchant, while gathering information on consumer satisfaction regarding current offerings. [Column 7, lines 35-37] By definition, consumer satisfaction surveys pertain to the quality of a service or product offered by a merchant. The applicant has specified that user responses can be 2-level (e.g., satisfied or not satisfied) or 5-level (e.g., very satisfied, satisfied, neutral, unsatisfied, and very unsatisfied). These same metrics can be used to voice an opinion on a variety of subjects, including customer satisfaction level and level of support for a particular political candidate.

As per claim 6, Tedesco et al. teaches the system of claim 1, wherein said point-of-transaction comprises at least one of a restaurant (snack or beverage machines), a hotel, a retail location, an automated teller machine (ATM), and an entertainment location (pay telephones or slot machines). [Column 3, lines 45-50]

As per claim 8, Tedesco et al. teaches the system of claim 1, wherein said point-of-transaction terminal comprises a credit card reader. [Column 4, lines 66-67 and Column 5, lines 1-5]

As per claim 9, Tedesco et al teaches the system of claim 1, wherein said point-of-transaction terminal comprises a point-of-sale terminal (credit card processing equipment). [Column 5, lines 2-5]

As per claim 10, Tedesco et al. teaches a system for conducting a consumer evaluation, comprising:

a credit card reader; [Column 4, lines 66-67] and
a point-of-transaction terminal operatively coupled to said credit card reader [Column 5, lines 1-5] , a survey being interactively and electronically displayed for said consumer at a time of a transaction. [Column 7, lines 33-40 and Column 9, lines 44-47]

As per claim 11, Tedesco et al. teaches a system for conducting a consumer evaluation, comprising:

a credit card reader [Column 4, lines 66-67] including:
a text display screen (LCD, LED) for displaying the information and messages [Column 5, lines 38-40]; and
an input unit (input device). [Column 4, lines 44-47]
and a point-of-transaction terminal operatively coupled to said credit card reader [Column 5, lines 1-5], a survey being interactively and electronically displayed for said consumer at a time of a transaction. [Column 7, lines 33-40 and Column 9, lines 44-47]

Tedesco et al. is silent regarding how credit card information is read using the credit card reader. However, it is inherent that card readers must swipe the magnetic stripe of the card to read credit card information.

As per claim 17, Tedesco et al. teaches the system of claim 10, wherein said credit card reader and said POT terminal are integrally formed in a same housing. [Column 4, lines 66-67 and Article 120 of Figure 1]

As per claim 19, Tedesco et al. teaches the system of claim 10, wherein said system is usable with a retail (vending machines) establishment. [Column 3, lines 50-55]

As per claim 20, Tedesco et al. teaches the system of claim 10, wherein said system is usable with an automatic teller machine (ATM). [Column 3, lines 44-48]

As per claim 21, Tedesco et al. teaches the system of claim 10, wherein said system is usable with a commodity providing (beverages, snacks, video tapes and children's toys) concern. [Column 3, lines 21-22] Tedesco et al. is silent regarding the location or placement of the vending machines, but it is inherent that vending machines can be placed in a variety of locations and business establishments, such as office buildings, hotel lobbies, and retail stores.

As per claim 23, Tedesco et al. teaches a method of conducting a survey, comprising:

while performing a transaction at a point-of-transaction terminal, presenting a plurality of choices to a customer [Column 3, lines 50-56];

entering the preferred choices of the customer (using an input device) [Column 4, lines 44-61]; and

recording (stores information in the customer response database) the entered choices. [Column 6, lines 1-3]

As per claim 27, Tedesco et al. teaches a commercial transaction and surveying system, comprising:

a presentation unit for presenting a plurality of choices [Column 3, lines 50-56];
an input unit for entering the preferred choices (using an input device) [Column 4, lines 44-61]; and

a recording unit (data storage device) for recording the entered choices (stores information in the customer response database), said plurality of choices being presented at a point-of-transaction. [Column 6, lines 1-3]

As per claim 28, Tedesco et al. teaches an automated teller machine, comprising:

a banking transaction system (point-of-sale credit card processing equipment) ;
and

a surveying system electronically linked to said banking transaction system such that at a point-of-transaction a survey is electronically presented to a customer.

As per claim 29, Tedesco et al. teaches the ATM of claim 28, wherein said surveying system comprises:

a presentation unit for presenting a plurality of choices [Column 3, lines 50-56];
an input unit for entering the preferred choices [Column 4, lines 44-61]; and
a recording unit for recording the entered choices [Column 6, lines 1-3].

As per claim 30, Tedesco et al. teaches an automated teller machine, comprising:

a point-of-transaction terminal (vending machine); and
a card reader [Article 120 of Figure 1] electronically coupled to said point-of-transaction terminal, said card reader comprising a display screen [Article 150 of Figure 1], a customer input device [Article 110 of Figure 1] and a mechanism for reading a card,

wherein substantially concurrently with a transaction, a survey is electronically received by said point-of-transaction terminal and displayed on said display screen for allowing a customer to participate in a survey [Lines 2-4 of Abstract].

As per claim 31, Tedesco et al. teaches a point-of-transaction device, comprising:

a point-of-transaction terminal (vending machine); and
a credit card reader [Article 120 of Figure 1] electronically coupled to said point-of-transaction terminal, said credit card reader comprising a display screen [Article 150

of Figure 1], a customer input device [Article 110 of Figure 1] and a mechanism for reading said credit card,

wherein substantially concurrently with a transaction, a survey is electronically received by said point-of-transaction terminal and displayed on said display screen for allowing a customer to participate in a survey [Lines 2-4 of Abstract].

As per claim 32, Tedesco et al. teaches a signal-bearing (computer readable) medium tangibly embodying (having computer readable code means embodied) a program of machine-readable instructions (computer readable program code) executable by a digital processing apparatus to perform a method of conducting a survey, comprising:

while performing a transaction at a point-of-transaction terminal, presenting a plurality of choices (at least one question) to a customer;

entering the preferred choices (receive an answer to the question) of the customer; and

recording the entered choices. [Claims 31, 56, and 84]

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tedesco et al. as applied to claims 1-11, 17, 19-21, 23, 27-32 above, and further in view of Ambrose et al (U.S Patent No. #US 6,783,028B1).

As per claim 22, Tedesco et al. fails to disclose the use of his teachings at non-traditional point-of-transaction terminals, such as gas pumps. Ambrose et al. teaches a system at a fuel dispensing station equipped with a fuel dispensing nozzle that enables the user to fuel vehicles while at the same time participating in a game, accept coupons, or participate in a survey or poll. [Column 2, lines 30-38, Figures 6-8] It would have been obvious to one of ordinary skill in the art at the time of invention to modify the teachings of Tedesco et al. to include the fuel dispensing nozzle taught by Ambrose et al. to make his teachings more versatile.

7. Claims 12-16 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tedesco et al. as applied to claim 10 above, and further in view of Zgodzinski ("Click Here to Pay") and Jheeta (U.S Patent #5,619,558).

As per claim 12, Tedesco et al. fails to disclose a payment gateway server to be used in processing transactions at a point-of-transaction terminal. Zgodzinski discloses software from IC Verify that passes along credit card information from the point-of-

transaction terminal (the SSLenabled browser on a customer's computer) to a payment gateway (merchant's) server. [Paragraph 26] However, the combined teachings of Zgodzinski and Tedesco et al. fail to disclose a survey processing center. Jheeta teaches a survey processing center (toll free telephone number for a service center conducting a survey). [Column 3, lines 1-12] It would have been obvious to one of ordinary skill in the art at the time of invention to include in the system of Tedesco et al. the payment gateway server of Zgodzinski to make his teachings compatible with existing banking infrastructure and the survey processing center of Jheeta to make his teachings more versatile.

As per claims 13 and 14, Tedesco et al. fails to disclose a network connection to the payment gateway server. Zgodzinski discloses software from IC Verify that passes along credit card information from the point-of-transaction terminal to a payment gateway server using a network (secure telephone connection). [Paragraphs 24 and 26] It would have been obvious to one of ordinary skill in the art at the time of invention to include in Tedesco et al. the secure telephone network disclosed by Zgodzinski to make his teachings both secure and compatible with existing banking infrastructure.

As per claim 15, Tedesco et al. fails to disclose a method of ordering a transfer of funds. Zgodzinski discloses software from IC Verify that passes along credit card information from the point-of-transaction terminal to a payment gateway server using a network to transmit the information to, and receive approval from, the financial

institutions. [Paragraphs 24 and 26] Zgodzinski also discloses the standard protocol for secure credit card transactions on the Internet, published by the Secure Electronic Transaction consortium (SET). [Paragraph 43] Upon receiving verification of involved parties, an order is made to transfer funds from the payer's bank to the payee's bank. [Paragraph 44]. It would have been obvious to one of ordinary skill in the art at the time of invention to include in Tedesco et al. the credit card transaction protocol taught by Zgodzinski to conform to standards published by the SET and also the method of transferring funds as described by IC Verify to make his teachings more versatile and ensure compatibility with existing banking infrastructure.

As per claim 16, Tedesco et al. is silent regarding a survey router for conducting a survey via credit card reader at a point-of-transaction terminal. The collective teachings of Tedesco et al., Zgodzinski, and Jheeta are silent regarding the use of a survey processing server to route survey questions and answers over a network. However, Official Notice is taken that it is old and well known in the art that credit card readers include a display screen, and that survey questions can be routed to the credit card reader display screen using a server, prompting users to enter their choice using the keypad. The user's survey results could be forwarded to a survey processing server using the same payment gateway used to verify the transaction. It would have been obvious to one of ordinary skill in the art at the time of invention that surveys could be conducted using a credit card reader at a point-of-transaction terminal if there existed a survey processing server to route survey questions and answers through a network to

the credit card reader since it would use existing methods transferring transaction information data between financial institutions.

As per claim 18, Tedesco et al. fails to disclose a payment gateway server and a survey processing center. Zgodzinski discloses software from IC Verify that passes along credit card information from the point-of-transaction terminal to a payment gateway (merchant's) server. [Paragraph 26] However, the combined teachings of Tedesco et al. and Zgodzinski fail to teach a survey processing server. Jheeta teaches a receipt printer at a point-of-transaction terminal (ATM) where the telephone number for a telephonic survey (conducted through a survey processing center) is printed on the bottom of a receipt. [Figures 3-4, Column 2, line 64 - Column 3, line 21, and Column 4, lines 22-46]. After customer responses to questions are stored in a database, the service center will send the customer the authorized reward payment. [Column 4, lines 1-12]. It would have been obvious to one of ordinary skill in the art at the time of invention to include in the system of Tedesco et al. the payment gateway server of Zgodzinski to make his teachings compatible with existing banking infrastructure. It would also have been obvious to one of ordinary skill in the art at the time of invention to include in the system of Tedesco et al. the survey processing server of Jheeta to make his teachings more versatile.

8. Claims 24-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Marcus et al (U.S Patent No. #5,650,604).

As per claims 24-25, Marcus et al teaches a credit card transaction method, comprising:

at a point-of-transaction terminal (ATM), reading a credit card of a customer by a card reader to read the card identification information; [Column 8, lines 23-30]

sending a transaction request to a payment gateway (switch of a pseudo terminal), to verify the transaction, order a transfer of funds from the customer's bank to a bank of the payee, and obtain an authorization or confirmation number (approval message and PIN); [Column 5, lines 56-58]

sending, by the payment gateway, an authorization number (approval message and PIN) to the POT terminal; [Column 6, lines 23-26]

Marcous et al. is silent regarding customer verification of the transaction. However, it would have been obvious to one of ordinary skill in the art at the time of invention to include a verification step in the credit card processing system of Marcus et al. because verification would eliminate processing of clearly wrong orders. This practice is used in retail store settings and on the Internet (in the form of an order confirmation page). The use and advantages of this step are well known.

Marcous et al. is also silent regarding the administration of a survey. As mentioned earlier, Official Notice was taken that survey questions can be electronically routed to the credit card reader display screen by a server, prompting users to enter

their choice using the keypad of the credit card reader. The same payment gateway used to process the transaction verification can be used to forward the user's answers to a survey processing server. Upon receiving the user's survey results, the survey processing server would be able to tabulate and analyze the results and authorizes reward payments (which may include an award of frequent flier miles, a discount on a future purchase, and a discount on a concurrent purchase) to the user. It would have been obvious to one of ordinary skill in the art to modify the method Marcus et al. by adding a survey processing server to make his teachings more versatile.

As per claim 26, Marcus et al. teaches a credit card transaction method, comprising:

at a point-of-transaction terminal (ATM), reading a credit card of a customer by a card reader to read the card identification information; [Column 8, lines 23-30]

sending a transaction request to a payment gateway (switch of a pseudo terminal), to verify the transaction, order a transfer of funds from the customer's bank to a bank of the payee, and obtain an authorization or confirmation number (approval message and PIN); [Column 5, lines 56-58]

sending, by the payment gateway, an authorization number (approval message and PIN) to the POT terminal; [Column 6, lines 23-26]

Marcous et al. is silent regarding customer verification of the transaction. However, it would have been obvious to one of ordinary skill in the art at the time of

invention to include a verification step in the credit card processing system of Marcus et al. because verification would eliminate processing of clearly wrong orders. This practice is used in retail store settings and on the Internet (in the form of an order confirmation page). The use and advantages of this step are well known.

Marcous et al. is also silent regarding the administration of a survey. Official Notice has been taken that survey questions can be electronically routed via a server to the credit card reader display screen, prompting users to enter their choice using the keypad of the credit card reader. The same payment gateway used to process the transaction verification can be used to forward the user's answers to a survey processing server. It would have been obvious to one of ordinary skill in the art to modify the method Marcus et al. by adding a survey processing server to make his teachings more versatile.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. U.S Patent No. #5,893,075 to Plainfield et al. teaches an interactive data processing system that induces customers of a restaurant, store or other business to participate in a survey. The survey seeks information regarding quality of service, the opinions and preferences of the customer, and offers customers a reward for participating.

U.S Patent No. #5,689,100 to Carrithers et al. teaches a debit card system implementing a reward program for participants. Customers can participate in this program from a multitude of places through a network of interconnecting merchants that form the debit card system.

U.S Patent No. #6,009,411 to Kepcs teaches a method and system for distributing electronic promotions to a consumer through the Internet. A series of computer servers connect point-of-sale terminals to the computers of financial institutions through the use of an Internet service provider.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter Choi whose telephone number is (703) 305-0852. The examiner can normally be reached on M-F 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz can be reached on (703) 305-9643. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

December 13, 2004



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